Paper No. 14
EWH/MM

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 1/13/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Karen L. Giblin

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Serial No. 74/732,385

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Evelyn M. Sommer for Karen L. Giblin.

Sandy Switzer, Trademark Examining Attorney, Law Office 112 (Janice Olear, Managing Attorney).

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Before Simms, Hanak and Quinn, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Karen L. Giblin (applicant) seeks to register PRIME PLUS for "educational services, namely, providing workshops, lectures, conferences and classes on the subject of menopause, directed to menopausal women." The intent-to-use application was filed on September 21, 1995.

The Examining Attorney refused registration on the basis that applicant's mark, as used in connection with

applicant's services, is likely to cause confusion with the mark PRIME REHAB, previously registered for "educational services, namely conducting classes, seminars, conferences, individual sessions and workshops in the field of psychology and medicine covering physical and psychological recovery from injury and other medical problems for medical professionals and patients and distributing course materials in connection therewith." Registration number 1,985,491.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key considerations are the similarities of the goods or services and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the services, it is the position of the Examining Attorney that the services of applicant and registrant are related "because both are educational

services related to health issues" and because the NEXIS "evidence of record shows that hospitals and other facilities offer both medical rehabilitation services and educational services in the areas of medical rehabilitation and women's health issues, including menopause." (Examining Attorney's brief page 4). Obviously, both applicant's services and registrant's services are educational services which are related to health issues. Applicant does not contend otherwise. Moreover, applicant further concedes that the services described in the cited registration would be offered by hospitals and that, at a minimum, applicant's services could be "provided at or even sponsored by a hospital." (Applicant's brief page 7).

Accordingly, we find that there is a relationship between registrant's and applicant's services such that the use of similar marks for both types of services would result in a likelihood of confusion.

Turning to a consideration of the marks, we find that the only common element is the highly laudatory word "prime." The word "prime" is defined as meaning "first in quality; of the highest excellence; first-rate." Webster's

New World Dictionary (2d ed. 1970). It is has been repeatedly held that highly laudatory words are descriptive. See 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:17 at pages 11-21 to 11-22 (4th ed. 1999). In addition, it is further been held that if the only word common to two marks is descriptive or even highly suggestive, a likelihood of confusion is rarely found. See In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1996) and Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976).

Other than sharing the highly laudatory, suggestive word “prime,” applicant’s mark is otherwise totally dissimilar from registrant’s mark. The PLUS portion of applicant’s mark is quite dissimilar from the REHAB portion of registrant’s mark in terms of visual appearance, pronunciation and meaning.

Accordingly, despite the fact that applicant’s services are related to registrant’s services, we find that when considered in their entireties, the two marks are dissimilar enough such that there is simply no

likelihood of confusion.

Decision: The refusal to register is reversed.

R. L. Simms

E. W. Hanak

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial and
Appeal Board